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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/635,629

08/10/2000

Junichi Kimura

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EXAMINER

DARROW, JUSTIN T

ART UNIT

PAPER NUMBER

2132

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/635,629

Applicant(s)

KIMURA, JUNICHI

Examiner

Justin T. Darrow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 12-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-20 have been presented for examination. Claims 1-9 and 12-16 have been amended, claims 10 and 11 have been cancelled, and new claims 17-20 have been added in an amendment filed 10/01/2004. Claims 1-9 and 12-20 have been examined.

Priority

2. Receipt is acknowledged of a paper submitted under 35 U.S.C. 119(a)-(d), which paper has been placed of record in the file.

3. Acknowledgment is made for the benefit of an earlier filing date of Application No. 2000JP-222389 filed in Japan on 07/18/2000.

Drawings

4. Applicant's arguments, see remarks of Paper No. REM(10/07/2004), page 12, lines 17-22 and page 13, lines 1-6, filed 10/01/2004, with respect to figures 1-5 have been fully considered and are persuasive. The objection to these figures has been withdrawn.

Response to Arguments

5. Applicant's arguments, see remarks of Paper No. REM(10/07/2004), page 13, lines 17-24, page 15, lines 21-26, page 16, and page 17, lines 1-17, filed 10/01/2004, with respect to the rejection of claims 12 and 13 under 35 U.S.C. 102(b) as being anticipated by Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further

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consideration, a new grounds of rejection necessitated by amendment is made in view of Fuji Photo Film Co. Ltd. (Watanabe et al.), Japanese Patent Application Publication No. 11-224228 A and Suzuki, U.S. Patent No. 6,401,243 B1.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 recites the limitation "said destination information" in line 11. There is insufficient antecedent basis for this limitation in the claim. This rejection can be overcome by deleting "said" in line 11 and replacing with --a--.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000 or a U.S. patent with no common inventors nor common assignees resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

9. Claims 12 and 13 are rejected under 35 U.S.C. 102(a) as being anticipated by Fuji Photo Film Co. Ltd. (Watanabe et al.), Japanese Patent Application Publication No. 11-224228 A.

As per claim 12, Watanabe et al. describe a multimedia communication terminal apparatus comprising:

means for receiving and storing [see specification, page 16, lines 15-17; figure 11, item 161; a transmitter receiving and storing] an ID code specifying a still image stored in a storage of a server (see computer translation; ¶ [0041] and ¶ [0045]; Drawing 2, items 14 and 18; receiving an order file containing an image ID for an image stored in a database);

means for creating [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter creating] a destination information (see computer translation; ¶ [0050]; drawing 3, item 25; a destination address for User's B mail address); and

means for transmitting [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter transmitting] the ID code and the destination information to the server to distribute

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the video bitstream specified by the ID code to the destination specified by the destination information (see computer translation; ¶ [0050]; drawing 3, items 6b, 23, 25, and 27; User A transmits a request to the image database with the image ID and the destination address of User B to have the image sent to User B).

The “means for receiving and storing,” “means for creating,” and “means for transmitting” limitations explicitly recited in claim 12 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 13, Watanabe et al. illustrate a video distribution server, comprising:
means for receiving and storing [see specification, page 16, lines 9-14; figure 11, item 123; a storage device for receiving and storing] into a storage still image information in association with a first ID uniquely specifying the still image information (see computer translation; ¶ [0041] and ¶ [0045]; Drawing 2, items 7 and 18; an image is scanned into a database from film with an image ID);

means for receiving [see specification, page 16, lines 19-23; figure 11, item 163; a distribution server for receiving] from a communication terminal a transmission request including the destination information and second ID identifying the video (see computer translation; ¶ [0045]; drawing 2, items 14; transmitting an order file containing an identifier for the image data as a second ID),

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retrieving from the storage a still image information having the first ID matched with second ID (see computer translation; ¶ [0046]; drawing 2, items 14, 20, and 18; analyzing the content of the order file to determine that the identifier corresponds to the image ID and reading the image data from the database), and

distributing the retrieved to a destination specified by destination information (see computer translation; ¶ [0050]; drawing 3, items 6b, 23, 25, and 27; database sends the image with the image ID to User B with destination address of User B).

The “means for receiving and storing” and “means for storing” limitations explicitly recited in claim 13 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

10. Claims 12 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki, U.S. Patent No. 6,401,243 B1.

As per claim 12, Suzuki shows a multimedia communication terminal apparatus comprising:

means for receiving and storing [see specification, page 16, lines 15-17; figure 11, item 161; a transmitter receiving and storing] an ID code specifying a video bitstream stored in a storage of a server (see column 14, lines 54-64; transmission program specifying information (program identifying data) for specifying a video program requested for distribution by a user in a demand signal);

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means for creating [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter creating] a destination information (see column 14, lines 54-64; a user ID as an identification code of each subscriber assigned to; see column 10, lines 10-18; a control channel); and

means for transmitting [see specification, page 16, lines 17-21; figure 11, item 161; a transmitter transmitting] the ID code and the destination information to the server to distribute the video bitstream specified by the ID code to a destination specified by the destination information (see column 13, lines 66-67; column 14, lines 1-10; subscribers send demand signals for programs for distribution specifying; column 14, lines 54-64; transmission program specifying information (program identifying data) for specifying a video program requested for distribution by a user in a demand signal; a user ID as an identification code of each subscriber assigned to; see column 10, lines 10-18; a control channel).

The “means for receiving and storing,” “means for creating,” and “means for transmitting” limitations explicitly recited in claim 12 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

As per claim 13, Suzuki depicts a video distribution server, comprising:

means for receiving and storing [see specification, page 16, lines 9-14; figure 11, item 123; a storage device for receiving and storing] into a storage a video bitstream in association with a first ID uniquely specifying the video bitstream (see column 6, lines 36-49; figure 4, item

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22; a tape information library storing video tapes with; see column 13, lines 55-65; figure 11; a list of programs identifying individual programs; see column 13, lines 16-19; figure 10, item 1; relayed to a digital information source);

means for receiving [see specification, page 16, lines 19-23; figure 11, item 163; a distribution server for receiving] from a communication terminal a transmission request including the destination and second ID identifying the video (see column 18, lines 47-55; figure 10, item 5; figure 6, step S11; a demand receiving analysis means receives demand signals from subscribers for programs for distribution specifying; column 14, lines 54-64; transmission program specifying information (program identifying data) for specifying a video program requested for distribution by a user in a demand signal; a user ID as an identification code of each subscriber assigned to; see column 10, lines 10-18; a control channel),

retrieving from the storage a video bitstream having first ID matched with second ID (see column 19, lines 16-18; figure 16, step S18; transmitting the video program specified by program identification data from the digital source)

forwarding the appropriate video to the destination (see column 19, lines 16-18; figure 16, step S18; transmitting the video program to the subscriber in real-time for copying).

The “means for receiving and storing” and “means for storing” limitations explicitly recited in claim 13 are construed to cover the corresponding structure described in the specification and the equivalents thereof. See MPEP § 2181, 35 U.S.C. § 112, ¶ 6, and *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ2d 1845, 1850 (Fed. Cir. 1994) *en banc*.

Allowable Subject Matter

11. Claims 1-9 and 15-20 are allowed.
12. Claim 14 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
13. The following is an examiner's statement of reasons for allowance:

Claims 1 and 4-6 are drawn to a video or still image information generating apparatus. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Jung et al., U.S. Patent No. 4,862,290 A, disclose a similar apparatus. Although Itoh et al. describe an accounting circuit for carrying out remittance processing after the image information has been descrambled for viewing (see ¶ [0007], figure 1, item 14), none of these inventors show or motivate a processor unit operatively connected to a camera for adding a copy protection code corresponding to a paid fee to a video bitstream or still image information created by the camera for output. This particular feature explicitly recited in independent claim 1 renders claims 1 and 4-6 allowable.

Claim 2 is drawn to video or still image generating apparatus. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A, discloses a similar apparatus. Although Itoh et al. describe remittance processing after the image information has been descrambled for viewing (see ¶ [0007], figure 1, item 14) and providing copy preventative information (see ¶ [0006]; figure 1, item 11), Itoh et al. neither show nor imply a means for creating a copy protection code with the video bitstream or still image information

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depending on a paid fee. This distinct feature explicitly recited in independent claim 2 renders it allowable.

Claims 3 and claim 9 are drawn to two video or still image information generating apparatus, respectively. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Jung et al., U.S. Patent No. 4,862,290 A, disclose a similar apparatus. Although Itoh et al. show decoder IC card to control a decoder in accordance a user's choice of programming which checks for required charges (see ¶¶ [0006]-[0007]; figure 1, items 8 and 22), none of these inventors describe or suggest a means for feeding to an external entity via an interface a video bitstream or still image information together with a copy protection code created depending on an amount of a paid fee in response to an instruction from a user indicating that the video bitstreams or still image information displayed is acceptable. This particular limitation explicitly incorporated in independent claims 3 and 9 renders them, respectively, allowable.

Claims 7 and 8; and 17-20 are drawn to two video or still image information generating apparatuses. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Jung et al., U.S. Patent No. 4,862,290 A, disclose similar apparatuses. Although Itoh et al. describe an accounting circuit for carrying out remittance processing after the image information has been descrambled for viewing (see ¶ [0007], figure 1, item 14), none of these inventors show or motivate a camera means for creating and recording video or a still image for a predetermined period of time in response to a start recording instruction from a user in a condition that an appropriate fee is paid or positively

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charged. This particular feature explicitly recited in independent claims 7 and 17 renders claims 7 and 8; and 17-20, respectively, allowable.

Claim 15 is drawn to a video or still image information system. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A in view of Jung et al., U.S. Patent No. 4,862,290 A, disclose a similar system. Although Itoh et al. describe an accounting circuit for carrying out remittance processing after the image information has been descrambled for viewing (see ¶ [0007], figure 1, item 14), none of these inventors depict or imply a means for creating and recording video or a still image in a condition that a necessary fee is paid or will be positively paid and a controller means for inhibiting the transmission of the video bitstream or still image information when a number of allowed copies specified by a copy protection code becomes zero. This combination of features explicitly recited in independent claim 15 renders it allowable.

Claim 16 is drawn to a video or still image information system. The closest prior art, Hitachi Ltd. (Itoh et al.), Japanese Patent Application Publication No. 08-107389 A disclose a similar system. However, Itoh et al. neither show nor motivate a means for creating a video bitstream or still image information in condition that an appropriate fee is paid or will be positively paid at a predetermined time; and a means for outputting the video bitstream or still image information together with a copy protection code issued in correspondence with a fee paid. This combination of limitations explicitly incorporated in independent claim 16 renders it allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

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fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

14. The following is a statement of reasons for the indication of allowable subject matter:

Claim 14 is drawn to a video or still image distribution server. The closest prior art, Fuji Photo Film Co. Ltd. (Watanabe et al.), Japanese Patent Application Publication No. 11-224228 A, in view of Suzuki, U.S. Patent No. 6,401,243 B1, disclose a similar server. Although Watanabe et al. describe the order file from the user specifying an image ID with a print number of sheets for the image, none of these inventors teach or suggest a copy protection code updated by a management unit for each time of distribution so as to inhibit distribution of a video bitstream or still image information when the copy protection code reaches a predetermined number. This distinct feature explicitly incorporated into dependent claim 14 renders it to have allowable subject matter.

Conclusion

15. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Justin T. Darrow whose telephone number is (571) 272-3801, and whose electronic mail address is justin.darrow@uspto.gov. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barrón, Jr., can be reached at (571) 272-3799.

The fax number for Formal or Official faxes to Technology Center 2100 is (703) 872-9306. In order for a formal paper transmitted by fax to be entered into the application file, the paper and/or fax cover sheet must be signed by a representative for the applicant. Faxed formal papers for application file entry, such as amendments adding claims, extensions of time, and statutory disclaimers for which fees must be charged before entry, must be transmitted with an authorization to charge a deposit account to cover such fees. It is also recommended that the cover sheet for the fax of a formal paper have printed "**OFFICIAL FAX**". Formal papers transmitted by fax usually require three business days for entry into the application file and consideration by the examiner. Formal or Official faxes including amendments after final rejection (37 CFR 1.116) should be submitted to (703) 872-9306 for expedited entry into the application file. It is further recommended that the cover sheet for the fax containing an

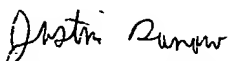
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amendment after final rejection have printed not only **"OFFICIAL FAX"** but also **"AMENDMENT AFTER FINAL"**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

March 10, 2005


JUSTIN T. DARROW
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100